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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/843,711	04/16/1997	CELSO S.J. BAGAOISAN	22965.2111	6568

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EXAMINER

KENNEDY, SHARON E

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 04/18/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/843,711

Applicant(s)
Bagaoisan et al.

Examiner
Sharon Kennedy

Art Unit
3762



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-23 is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 24-31 is/are rejected.
- 7) ☒ Claim(s) 2, 4, and 5 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action and the MPEP.

Claim Rejections - 35 USC §251, Recapture

2. Claims 24-31 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Applicant has broadened numerous aspects of the claims rejected in the patent without narrowing another separately patentable feature, and presents them here in the reissue application. Note that the same art used to reject originally presented claims in the parent application are used here to reject new claims 24-30.

Claim Rejections - 35 USC § 102

3. Claims 1, 25-28, 30 and 31 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hernandez, US 5,269,759. Hernandez shows the elongated tubular proximal shaft section as the holding attachment 20, an elongated distal shaft section as the guide catheter 10, the third inner lumen being the lumen through the balloon catheter 14 which supports the guidewire, and the connecting means are described at column 5, lines 63-65. Applicant may argue that Hernandez does not disclose an “elongated” proximal shaft, however, applicant provides no qualitative or quantitative description of “elongated,” nor is this a term of art. Accordingly, this term can not be accorded sufficient patentable weight to define over the Hernandez holding attachment 20. Regarding method claim 27, Hernandez shows the identical device which is also used in the vascular system. It would be obvious to remove holding attachment 20, then guide catheter 10 is another catheter were to be inserted over the guide wire, which, according to applicant’s disclosure, occurs often.
4. Claim 28 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Groshong, US 4,431,426. As is well established, intended use is non-limiting in the absence of distinguishing structural characteristics. See also MPEP 2112.01.
5. Claims 25, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Polin, US 3,828,782. Note the comments set forth in 08/250,785, first office action. See threads 34 which connect the proximal and distal ends.
6. Claims 25, 28, 30 and 31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Alexander, US 4,004,588. See, for example, the abstract.

Claim Rejections - 35 USC § 103

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez '759. It would be an obvious engineering design choice to exchange on common connecting means for another, particularly in view that applicant's specification (patent, column 5, lines 40+) indicates that variations in the connecting means are equivalents for the purpose of the invention.

8. Claims 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander, US 4,004,588. Alexander discloses the identical apparatus but does not show the specific disengagement. However, in column 4, lines 25-30, Alexander discloses that an array of differing flexible conduits may be provided. It would be obvious to disengage the Alexander conduit if during a procedure the surgeon discovers that a conduit needed more flexibility, etc., particularly in view that applicant's disclosure states that the need to change conduits occurs often.

Response to Arguments

9. Regarding the arguments against recapture, applicant argues that amendments are required for a finding of recapture. However, recapture bars claims having the same or broader scope in all aspects, regardless of what amendments were made in the parent. See especially *Ball*, 729 F.2d at 1436, 221 USPQ at 295. Applicant misrepresents the law of recapture.

10. Applicant's arguments filed August 12, 2002 have been fully considered but they are not persuasive. Applicant's comments are very unusual. It appears the wrong reference may have been examined to craft the response to the previous office action. Regardless, applicant claims

that Hernandez fails to disclose a port (28) located in the distal end of the distal shaft section. Clearly the Hernandez guide catheter 10 has a distal port. In fact, the guide wire 12b is even sticking out of the end. Regarding the first lumen, clearly Hernandez holding attachment 20 is not solid and has a lumen. Regarding the second lumen, clearly the Hernandez guide catheter 10 is not solid and has a lumen. Regarding the third inner lumen, clearly Hernandez balloon catheter 14 is not solid and has a lumen. Regarding the guide wire, clearly balloon catheter 14 is shown with a guide wire 12. Regarding the releasable connection, see Hernandez Leur fitting 24 which attaches to the Hernandez holding attachment 20. Applicant's further comments are also unpersuasive, and misrepresent the Hernandez invention.

11. In response to applicant's argument that the Groshong fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In other words, applicant shows a threaded connection, Groshong shows a threaded connection, how does "alternatively connectable and separable" define over Groshong? The function language in part c does not clarify the features of part b so that the claim defines over the embodiments of Groshong.

12. Regarding claims 25, 28 and 30, applicant argues that Polic fails to teach a third lumen, however, none of claims 25, 28 and 30 set forth a third lumen.

13. Regarding Alexander, applicant failed to address the 35 USC 102 rejection. It is hard to believe that applicant cannot read and understand Alexander without a comment from the

examiner. See the abstract. Note threads 21. This is the whole point of Alexander, not some obscure feature that needs to be pointed out. Regarding the 35 USC 103 rejection, the motivation is found in the common sense performance of a medical procedure. A surgeon is not an mindless automaton, and will switch a catheter if necessary.

Allowable Subject Matter

14. Claims 2, 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 6-23 are allowed.

Conclusion


16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Kennedy whose telephone number is (703) 305-0154.

April 16, 2003


Sharon Kennedy
Primary Examiner